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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,333	05/22/2002	Hirofumi Johoji	7372/72558	6443

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EXAMINER

NUTTER, NATHAN M

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 08/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/031,333

Applicant(s)

JOHOJI ET AL.

Examiner

Nathan M. Nutter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 803. 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Since claim 1 relates to a composition defined by reference to desirable characteristics or properties, the specification fails to supply sufficient teachings to enable one having an ordinary skill in the art to know what constituents may be employed, without the undue burden of experimentation. In claim 1, the "olefin copolymer" is specified only by the results of evaluation of an intrinsic property "tensile strength at break based on JIS K6251", and approximate values derived from the results of evaluation (the variables in expression 1 and expression 2). In relation to the process for producing an "olefin copolymer", the Specification discloses at the paragraph bridging page 24 to page 25 the employment of either "a Ziegler-Natta catalyst...used in combination or a metallocene catalyst", and cites various production conditions at pages 16-75 and examples. It is clear that not all polymers that can be produced by a process indicated in pages 16-75 of the description are "olefin copolymers" as described in claim 1; only some polymers selected from polymers which

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can be obtained by a process indicated in pages 16-75 of the description are olefin polymers satisfying the conditions in claim 1, and thus these are polymers obtained by production under conditions selected from the polymerization conditions indicated in pages 16-75 of the description.

In producing the olefin copolymers, the properties of the resulting copolymer can be markedly changed by small changes in numerous conditions such the catalyst and the monomers, and there is no theoretically established correlation between conditions and polymer properties. Therefore, although the intended olefin polymer may have a defined nature or property, it is difficult to completely design the production conditions beforehand so as to obtain this nature or property, and it is ordinarily necessary to establish a production process by repeated experimentation.

The Specification, therefore, does not fully enable claim 1; and claims 2-9, in which an "olefin copolymer" of claim 1 is a constituent, are also not fully enabled by the description.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

From the Specification, it is impossible to determine the proper metes and bounds of what may be described as "olefin copolymers" in claim 1. Since the

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composition of the olefin copolymer is determined by the production conditions, it is impossible to specify the composition of "olefin copolymers" of Claim 1. Therefore, the recitation of "olefin copolymers" in claim 1 renders the claim as unclear. Consequently, "thermoplastic resin compositions" of claims 2 and 3, "pellets" of claim 4, "moulded products" of claim 5, "sheet or film" of claim 6, "laminate" of claim 7, "base material sheet or film" of claim 8 and "tacky adhesion sheet or film" of claim 9, which include an "olefin copolymer" of claim 1 as a constituent, are also unclear.

The fact that the process for producing "olefin copolymers" of Claim 1 is unclear means that aspects such as the permitted monomer composition are also unclear, so that the "olefin copolymers" of claim 1 cannot be fully specified.

Claim 1 contains a "period" at line 9, rendering the claim as vague since it is in sentence fragments.

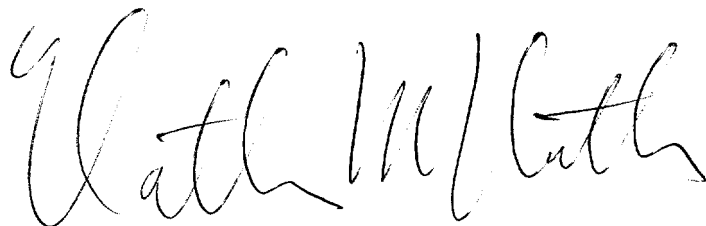
The references to Johoji et al and Nishihara et al, both cited of interest, teach the manufacture of resin blends similar in scope to those herein claimed. Note the Abstract of each patent. The patents teach the production of thermoplastic resins that employ an olefin and a thermoplastic resin as herein recited and claimed. Note the claims of each reference.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 703-308-2443. The examiner can normally be reached on Monday-Friday 9:30 am to 6:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 703-308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

A handwritten signature in cursive script, reading "Nathan M. Nutter". The signature is written in dark ink and is positioned above the printed name and title.

Nathan M. Nutter
Primary Examiner
Art Unit 1711

nmn
August 5, 2003